

REMARKS

Claims 1 through 58 are currently pending in the application. Claims 1-3, 6, 7, 14, 24-26, 29 have been amended, claims 8, 15, 30, 31, 34 and 35 have been cancelled without prejudice or disclaimer, and new claims 59-63 have been added herein. Applicant respectfully requests reconsideration of the application as amended herein.

The amendments to claims 1 and 6 and the addition of claims 61-63 find support in at least paragraph [0037] of the as filed specification. The amendments to claims 24 and addition of claims 59 and 60 find support in at least paragraph [0039] of the as-filed specification. Amendments to claims 2, 3, 6, 7, 14, 25, 26 and 29 include amendments to correct antecedent bases and incorporate subject matter previously submitted in other claims.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on NYRA One Account (“NYRA”)

Claims 1-3, 5-10, 12-20, 23-32, 35-49, 51-55, and 58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA One Account (“NYRA”). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether there is “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure.

DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co., 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.\

Claims 1-3, 5-10, 12-20 and 23

The 35 U.S.C. § 103(a) obviousness rejections of independent claim 1 is improper because NYRA fails to teach or suggest “depositing funds into the monetary account at the gaming terminal using at least one vehicle selected from the group consisting of cash, check, debit charge, credit card charge, and direct deposit,” as recited in claim 1, as amended. NYRA teaches that deposits are made at the track by taking cash to a pari-mutuel window and receiving a voucher to be deposited with a Sam machine. For depositing a check, which may include money orders and traveler’s checks, NYRA requires that a patron “go to the Clubhouse Customer Services Booth[, f]ill out a deposit form and give it to any one of the Customer Service representatives on duty.” *NYRA* at p. 2-3. Deposits by Credit Card require that a patron call an operator, who will transfer the patron to an agent who will process the request. *Id.* at p. 4. Each of these deposits require a patron to work with a person, either face-to-face or over the phone. Thus, NYRA fails to teach or suggest “depositing funds into the monetary account at the gaming terminal using at least one vehicle selected from the group consisting of cash, check, debit charge, credit card charge, and direct deposit.”

As NYRA fails at least to teach or suggest “depositing funds into the monetary account at the gaming terminal using at least one vehicle selected from the group consisting of cash, check, debit charge, credit card charge, and direct deposit,” as recited in independent claim 1, Applicants respectfully assert that independent claim 1 would not have been obvious to a person of ordinary skill in the art at the time the invention was made based on the description of NYRA, and request that the Examiner withdraw the rejection of independent claim 1 under 35 U.S.C. § 103(a).

Furthermore, the nonobviousness of independent claim 1 precludes a rejection of claims 2, 3, 5-10, 12-20 and 23, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596,

1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 2, 3, 5-10, 12-20 and 23, in addition to the rejection to independent claim 1.

Claims 24-32 and 35-39

The rejection of independent claim 24 is improper because NYRA fails to disclose “presenting a house card associated with a monetary account to a card reader in communication with the gaming terminal to access at least a portion of funds of the monetary account for use at the gaming terminal by debiting the monetary account, the house card comprising an anonymous token card in which the identity of the player is not known to the establishment,” as recited in claim 24, as amended. Applicants are unable to find anywhere in NYRA which teaches that a user may obtain a card anonymously such that the identity of the player is not known to the establishment.

As NYRA fails at least to teach or suggest “the house card comprising an anonymous token card in which the identity of the player is not known to the establishment,” as recited in independent claim 24, Applicants respectfully assert that independent claim 24 would not have been obvious to a person of ordinary skill in the art at the time the invention was made based on the description of NYRA, and request that the Examiner withdraw the rejection of independent claim 24 under 35 U.S.C. § 103(a).

Furthermore, the nonobviousness of independent claim 24 precludes a rejection of claims 25-32 and 35-39, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 25-32 and 35-39, in addition to the rejection to independent claim 24.

Claims 40-49, 51-55, and 58

The rejection of independent claim 40 is improper because NYRA fails, at least, to disclose “placing a purchase of goods or services sold at an establishment, other than a pari-mutuel wager, over the communication link using another portion of the funds,” as recited in

claim 40. NYRA is limited to placing a pari-mutuel wager using a card and a Sam or Tiny Tim machine at a race track or, alternatively, over the phone. The user is limited to placing only a wager and cannot make any purchases of goods or services using the card, and, more particularly, purchase goods or services over a communication link. The Examiner has not asserted any such disclosure in NYRA nor given any reason why NYRA should be read as teaching such elements.

As NYRA fails at least to teach or suggest the features of independent claim 40 listed above, Applicants respectfully assert that independent claim 40 would not have been obvious to a person of ordinary skill in the art at the time the invention was made based on the description of NYRA, and request that the Examiner withdraw the rejection of independent claim 40 under 35 U.S.C. § 103(a).

Furthermore, the nonobviousness of independent claim 40 precludes a rejection of claims 41-49, 51-55, and 58, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 41-49, 51-55, and 58, in addition to the rejection to independent claim 40.

Regarding dependent claim 51, Applicants additionally assert that NYRA fails to teach or suggest “selecting the monetary account to be associated with a debit or credit card,” as recited in dependent claim 51. The Examiner fails to particularly recite any teaching or suggestion in NYRA relating the claim 51. Indeed, nothing in NYRA teaches a house card associated with a debit or credit card account. Instead, a user must make a transfer from a credit or debit card by calling an operator, be transferred to an agent, and then request the transfer. *See NYRA* at p. 4. If the account were associated with a credit or debit card, such a method for transferring funds from a credit or debit card would not be necessary. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 103(a) for this additional reason.

Regarding dependent claim 55, Applicants additionally assert that NYRA fails to teach or suggest “selecting the house card to be associated with a first monetary account and with a second monetary account associated with a debit card account or a credit card account,” as

recited in dependent claim 55. Nothing in NYRA teaches a house card associated with more than one account. Additionally, as discussed above, NYRA does not teach the use of a monetary account associated with a debit or credit card account. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 103(a) for this additional reason.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,307,956 to Black

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Black (U.S. Patent No. 6,307,956). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 4 is dependent from claim 1 and further requires using the house card to access a secure area at the establishment. The Examiner relies on NYRA as disclosing all of the limitations of claim 1 in combination with Black. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claim 1. Thus, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 4, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,558,255 to Walker

Claims 11 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Walker (U.S. Patent No. 6,558,255). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 11 is dependent from claim 1 while claim 50 is dependent from claim 40. Claims 11 and 50 further require selecting the house card to have a predenominated amount of funds. The Examiner relies on NYRA as disclosing all of the limitations of claims 1 and 40 in combination with Walker. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 1 and 40. Thus, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 11 and 50, since a

dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,379,248 to Jorasch *et al.*

Claims 21, 22, 56 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Jorasch *et al.* (U.S. Patent No. 6,379,248). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 21 and 22 depend indirectly from claim 1 while claims 56 and 57 depend indirectly from claim 40. The Examiner relies on NYRA as disclosing all of the limitations of claims 1 and 40 in combination with Jorasch *et al.* As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 1 and 40. Applicants, therefore, respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 21, 22, 56 and 57, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA in view of U.S. Patent No. 6,547,131 to Foodman

Claims 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA in view of Foodman (U.S. Patent No. 6,547,131). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 33 and 34 depend indirectly from claim 24. The Examiner relies on NYRA as disclosing all of the limitations of claim 24 in combination with Foodman as disclosing the limitations in claims 33 and 34. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 24. Therefore, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 33 and 34, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

ENTRY OF AMENDMENTS

The amendments to claims 1-3, 6, 7, 14, 24-26, 29, as well as the addition of claims 59-63 above should be entered by the Examiner because, as noted above, the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 1-7, 9-14, 16-29, 32, 33 and 36-63 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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